

## REMARKS

### *Claim Status*

Claims 1-32 are pending. Claims 1, 13-17, and 29-32 stand rejected. Claims 2-12 and 18-28 stand objected to as being dependent on a rejected claim, but otherwise allowable. Applicant appreciates the examiner's indication of allowable subject matter. Applicant respectfully traverses the rejections and objects and requests reconsideration and withdrawal of the rejections of claims 1-32 in view of the following.

### *Examiner Interview*

Applicant appreciates the examiner interview conducted on August 22, 2005. While no agreement was reached on the claims, applicant requested clarification on where the examiner was citing in U.S. Patent No. 5,938,424 to Kurogi et al., hereinafter "Kurogi" as disclosing a "test result being determined from a test taken during transformer manufacture." Based on the interview, it is the applicant's understanding that the examiner is relying on inherency for such disclosure. The examiner particularly noted Fig. 2 and col. 3, lines 1-4.

### *Rejections under 35 U.S.C. § 102*

#### *Independent Claims 1 and 17*

Claims 1 and 17 have been rejected under 35 U.S.C. § 102 as allegedly being anticipated by Kurogi. Independent claims 1 and 17 include features that are not disclosed or suggested by the cited reference, namely as represented by claim 1:

1. (Original) A method for transformer testing, comprising:  
*receiving a failing test result of a transformer, the test result being determined from a test taken during transformer manufacture;*  
determining, via a knowledge-based system, a predicted root cause of the failure based on the test result and a knowledge base of transformer information; and  
determining, via the knowledge-based system, a suggested course of action for the failure based on the test result and the knowledge base of transformer information. (emphasis added)

Applicant's understanding of the rejection (based on the examiner interview) is that Kurogi does not explicitly disclose a test result being determined from a test taken *during*

*transformer manufacture*, as recited by the claims. Applicant's understanding (based on the examiner interview) is that the examiner is taking the position that this feature is inherently disclosed in Kurogi. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original), MPEP 2112.

Applicant respectfully submits that, in Kurogi, it is not necessary that any testing be taken during transformer manufacture, as recited by the claims. While Kurogi discloses an ignition transformer (Fig. 2, element 19) that is a component of a combustion system, it is not necessary that any testing be done during transformer manufacture. Fig. 2 shows a transformer that has *already been manufactured* and is ready for operation within the combustion system. During the interview, the examiner seemed to be relying on the first few lines of column 3 as the basis for the inherency rejection. This section of Kurogi, however, only states that there is a relationship between causes of failure and symptoms in a combustion system. That does not mean that any testing must necessarily be done during *transformer manufacture* (the transformer being only a component of the combustion system). The testing could be done after assembly of the combustion system and during operation of the combustion system (which is what Kurogi discloses, see col. 2, lines 10-11) and well after transformer manufacture.

Accordingly, applicant respectfully submits that independent claims 1 and 17 are allowable. Additionally, inasmuch as dependent claims 2-16 and 18-32 (which have also been rejected) are dependent on one of claims 1 and 17, these claims are patentable, at least by virtue of their dependency. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1-32 under 35 U.S.C. § 102.

### ***Conclusion***

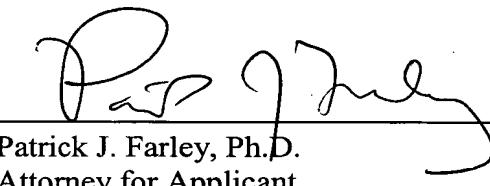
For the foregoing reasons, applicant respectfully submits that the present application is now in condition for allowance. Reconsideration of the Office Action and an early Notice of Allowance are respectfully requested. In the event that the examiner cannot allow the

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**PATENT**

present application for any reason, the examiner is encouraged to contact the undersigned attorney, Raymond N. Scott Jr. at (215) 564-8951, to discuss resolution of any remaining issues.

Date: August 31, 2005



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